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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,955	11/21/2003	Tsutomu Taniguchi	60256 (70904)	3521
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EXAMINER				
ROBINSON, MYLES D				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,955

Applicant(s)

TANIGUCHI ET AL.

Examiner

Myles D. Robinson

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 3, 5 - 9 and 11 - 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 - 16 is/are allowed.
- 6) ☒ Claim(s) 1, 5 - 7, 11, 12 and 20 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 8 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 8/6/2008, and has been entered and made of record. Currently, **claims 1 – 3, 5 – 9, 11 – 16 and 18 – 20** are pending.

Response to Arguments

2. Applicant's arguments with respect to **claims 1 – 3, 5 – 9, 11 – 16 and 18 – 20** have been considered but are moot in view of the new ground(s) of rejection.

Drawings

3. The drawings were received on 8/6/2008. These drawings are acceptable.

Specification

4. The amendments to the title were received on 8/6/2008. These amendments are acceptable.

Claim Objections

5. Applicant is advised that should **claim 5** be found allowable, **claim 6** will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

one claim to object to the other as being a substantial duplicate of the allowed claim.
See MPEP § 706.03(k).

6. Applicant is advised that should **claim 11** be found allowable, **claim 12** will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.
See MPEP § 706.03(k).

7. **Claim 18** is objected to under 37 CFR 1.75 as being a substantial duplicate of **claim 19**. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 1, 5 – 7, 11, 12 and 20** are rejected under 35 U.S.C. 102(b) as being anticipated by **Eguchi** (U.S. Patent Application Publication No. 2001/0005268).

Referring to **claim 1**, Eguchi discloses a communications device (*see Figs. 1 – 2, facsimile server 1*) transmitting/receiving data over a network (*see Figs. 1 – 2, LAN 54, Internet N1*) and making a request for a response to a data transmission (*see Fig. 7 wherein first header 50A includes data "a" indicating that this acknowledgment e-mail is MDN (Message Disposition Notification) [paragraphs 0008, 0009 and 0061]*) from a receiving-end machine (*see Fig. 2 wherein clients C transfer data via mail server MS for e-mail communication [paragraph 0043]*), said device comprising:

data identifying means (*see Fig. 1, CPU 10 of facsimile server 1*) for determining whether data to be received over the network is response data to the response request (*see Fig. 4 wherein the facsimile server 1 receives an e-mail from the mail server MS at step 200 and determines whether it is an acknowledgement e-mail [i.e. response data to the response request] or an ordinary e-mail [i.e. other data] at step 201 [paragraphs 0044, 0046, 0048 – 0049 and 0055]*), and

receipt control means (*see Fig. 1, CPU 10*) for controlling receipt so as to preferentially receive data identified as the response data by the data identifying means over other data (*see Figs. 4 and 8B wherein facsimile server 1 refers to the original message ID "b" of the e-mail in step 202 in order to send the reception acknowledgment to the true transmitter whereas server 1 transfers an ordinary e-mail to a designated recipient in step 205 in a conventional manner such that the object of Eguchi's invention is to preferentially receive and process acknowledgment e-mails over those*

conventionally-received ordinary e-mails so that the true data transmitter of origin, whether a client or the communication apparatus itself, is correctly identified and properly notified [Abstract and paragraphs 0010 – 0011, 0044, 0055 and 0061]).

Referring to **claim 20**, the rationale provided in the rejection of claim 1 is incorporated herein. In addition, the apparatus of claim 1 performs the method of claim 20.

Referring to **claims 5 and 6**, the rationale provided above in the rejection of claim 20 is incorporated herein. The method of claim 20 is stored as a program of instructions of claims 5 and 6 within memory and executed by one or more processors (see Fig. 1, CPU 10, RAM 11, ROM 12 [paragraphs 0041 and 0045]).

Referring to **claim 7**, Eguchi discloses a communications device (see Fig. 1, facsimile server 1), comprising:

transmission/receipt means (see Fig. 1, NCU 15, LAN interface 19 [paragraph 0042 – 0043]) for transmitting/receiving data over a network (see Figs. 1 – 2, LAN 54, Internet N1 [paragraphs 0038 – 0040 and 0043]),

response request embedding means (see Figs. 1, 3A and 3B wherein facsimile server 1 comprises identification data storage 11a of RAM which appends acknowledgement request and message ID to headers while preparing outgoing messages before transmission [paragraphs 0045 and 0052 – 0053]) for embedding a response request for a response to a data transmission (see Fig. 7 wherein first header 50A includes data "a" indicating that this acknowledgment e-mail is MDN (Message Disposition Notification) [paragraphs 0008, 0009 and 0061]) from a receiving-end

machine in transmitted data (see Fig. 2 wherein clients C transfer data via mail server MS for e-mail communication [paragraph 0043]),

data identifying means (see Fig. 1, CPU 10 of facsimile server 1) for determining whether data to be received over the network is response data to the response request (see Fig. 4 wherein the facsimile server 1 receives an e-mail from the mail server MS at step 200 and determines whether it is an acknowledgement e-mail [i.e. response data to the response request] or an ordinary e-mail [i.e. other data] at step 201 [paragraphs 0044, 0046, 0048 – 0049 and 0055]), and

receipt control means (see Fig. 1, CPU 10) for controlling receipt so as to preferentially receive data identified as the response data by the data identifying means over other data (see Figs. 4 and 8B wherein facsimile server 1 refers to the original message ID “b” of the e-mail in step 202 in order to send the reception acknowledgment to the true transmitter whereas server 1 transfers an ordinary e-mail to a designated recipient in step 205 in a conventional manner such that the object of Eguchi’s invention is to preferentially receive and process acknowledgment e-mails over those conventionally-received ordinary e-mails so that the true data transmitter of origin, whether a client or the communication apparatus itself, is correctly identified and properly notified [Abstract and paragraphs 0010 – 0011, 0044, 0055 and 0061]).

Referring to **claims 11 and 12**, the rationale provided above in the rejection of claim 7 is incorporated herein. The apparatus of claim 7 performs the method steps stored as a program of instructions of claims 5 and 6 within memory and executed by

one or more processors (see Fig. 1, CPU 10, RAM 11, ROM 12 [paragraphs 0041 and 0045]).

Allowable Subject Matter

10. **Claims 13 – 16** are allowed.
11. **Claims 2, 3, 8 and 9** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Referring to **claims 2 and 8**, the innovative limitation that distinguishes the Applicant's claim is comparing the size of the received data against a predetermined threshold in order to determine whether the received data is actually response data to the response request.

Referring to **claims 3 and 9**, the innovative limitation that distinguishes the Applicant's claim is controlling storing such that there remains necessary empty space within storage means to store the response data after storing the received data.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

IETF RFC 2298 "An Extensible Message Format for Message Disposition Notifications" discloses a MIME content-type that may be used by a mail user agent or

electronic mail gateway to report disposition of a message after it has been successfully delivered to a recipient (*see Abstract*).

Tohki et al. (U.S. Patent Application Publication No. 2003/0163574) disclose a network communication device capable of setting information of whether or not the transmission confirmation response by message disposition notification (MDN) is required, according to a receiver when sending the e-mail (*see Abstract and Figs. 5, 6 and 8*).

Watanabe (U.S. Patent Application Publication No. 2003/0164990) discloses a facsimile apparatus wherein if a delivery confirmation mail has arrived, it is determined whether a delivery failure of image data transmission is notified by the delivery confirmation mail and only if it has been determined that the delivery failure is notified, an image based on the delivery confirmation mail is printed by a printer (*see Abstract and Figs. 2 – 5*).

Shibata et al. (U.S. Patent Application Publication No. 2003/0233421) disclose a network communication device provided with e-mail message composing means incorporating an MDN request and return transmission conditions into an e-mail message and further comprises an e-mail message transmitting/receiving means for recognizing the MDN request and the return transmission conditions (*see Abstract and Figs. 1 – 13, 15 – 20, 23 and 26*).

Yamaguchi (U.S. Patent Application Publication No. 2002/0054336) discloses an e-mail printing apparatus wherein the print of received e-mail is limited to prevent a

large quantity of meaningless pages of the received mail from being printed (*see Abstract and Figs. 9 and 11*).

Wing (U.S. Patent No. 6,650,440) discloses a communication system wherein a sending gateway device transmits a prepared e-mail message along with a first and a second confirmation requests to the receiving gateway device through a mailer device (*see Abstract and Fig. 4*).

Maeda (U.S. Patent No. 6,437,873) discloses an Internet fax apparatus which requests the receiving apparatus to transmit a reception confirmation message when transmitting the image file and then receives that reception confirmation message (*see Abstract and Figs. 2, 4, 7 and 9*).

Harkins et al. (U.S. Patent Nos. 5,513,126 and 5,689,642) disclose recipient prioritized communication channel profiles wherein receivers have additional control over network senders by defining an information filter which further controls sender channel access (to a receiver) by defining some channels as having priority of access, such as direct or delayed access, as well as selectively permitting senders to override the receiver profile (*see Abstracts and Fig. 3*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571)272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on (571) 272-7406. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Myles D. Robinson/
Examiner, Art Unit 2625
12/5/2008

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Supervisory Patent Examiner, Art Unit 2625